

**REMARKS**

The Office Action rejects claims 65-74 under 35 U.S.C. § 112, second paragraph, as being indefinite. Office Action at p. 2. The Office Action also rejects claims 38-51, 53-58, 61, and 63-75 under 35 U.S.C. § 103(a) as being unpatentable over Armellin (U.S. Patent No. 6,244,315), Haas (U.S. Patent No. 4,606,389), "Japan 215 (JP 6-183215)," "Japan 218 (JP 11-208218)," "Japan 907 (JP 63-116907)," and "Germany 624 (DE 3901624)." Id. at p. 3. The Office Action further rejects claims 45-47, 58-60, 62, and 63 under 35 U.S.C. § 103(a) as being unpatentable over the preceding references "and optionally further in view of Nakagawa et al. (US 6220320) or Japan 307 (JP 63-315307)." Id. at p. 10.

Applicant has attached herewith English translations of Japan 215, Japan 218, and Japan 907. In order to analyze Japan 215, Japan 218, and Japan 907, Applicant has relied on the attached English translations of these documents. All citations to these documents refer to these English translations.

By this Reply, Applicant has amended independent claim 38 and dependent claim 39. Additionally, Applicant has added new independent claims 76, 96, 97, 118, 119, and 121, as well as new dependent claims 77-95, 98-117, 120, and 122. Applicant respectfully submits that the originally filed application and drawings fully support the amendments to the claims. For example, support for new independent claim 76 appears at least at page 4, lines 25-30; page 5, lines 1-5; page 7, lines 1-6; page 11, lines 22-24; page 14, lines 29-31; page 15, lines 1-3; page 16, lines 18-23; Fig. 2 and claims 39, 43 and 49-51. And support for new independent claim 97 appears at least at page 4, lines 25-30; page 5, lines 1-5; page 6, lines 3-19; page 16, lines 3-11; Fig. 2

and claims 43 and 45-47. Applicant has cancelled claims 65-74. Claims 38-51, 53-64, and 75-122 are currently pending.

**Rejections under 35 U.S.C. § 103(a)**

Regarding the rejections of claims 38-51, 53-64, and 75 under 35 U.S.C. § 103(a), Applicant respectfully submits that the Office Action does not establish a *prima facie* case of obviousness. A proper obviousness rejection must address every claim feature. See M.P.E.P. § 2143.03. To establish a *prima facie* case of obviousness, the Office Action must provide a clear explanation with rational underpinnings that demonstrates why a person of ordinary skill in the art would have found the claimed subject matter obvious. M.P.E.P. § 2142.

In a pair of motorcycle tires according to any of claims 38-51, 53-64, and 75, "at least one circumferential groove extends at an equatorial plane of the front motorcycle tire within a central zone of the tread band of the front motorcycle tire" and "the tread band of the rear motorcycle tire comprises: an area defining a substantially null sea/land ratio within a central zone of the tread band of the rear motorcycle tire." None of the references cited in the Office Action teaches or suggests pairing front and rear motorcycle tires with different tread designs, much less the specific claim features of combining a rear motorcycle tire having a null sea/land ratio within a central zone of its tread band with a front motorcycle tire having a circumferential groove or a sea/land ratio of about 15% to about 30%.

The Office Action fails to plausibly address these deficiencies. The Office Action avoids directly discussing the references' failure to suggest different sea/land ratios for front and rear motorcycle tires, it mischaracterizes the references' disclosures regarding

selection of front and rear motorcycle tires, and it attempts to hedge its positions with non-analogous art that teaches away from the claimed invention.

Rather than squarely considering the references' failure to suggest pairing front and rear motorcycle tires with different sea/land ratios, the Office Action appears to assume that those of ordinary skill in the art select the front and rear motorcycle tires of a pair independently. With this assumption, the Office Action avoids the principal deficiency of the references by considering separately the questions of 1) whether a person of ordinary skill in the art would have found it obvious to use a front motorcycle tire having a circumferential groove or a sea/land ratio of about 15% to about 30% and 2) whether a person of ordinary skill in the art would have found it obvious to use a rear motorcycle tire having a null sea/land ratio within a central zone of its tread band. See Office Action at pp. 3-5. This attempt to divide and conquer Applicant's claims by considering the front and rear tires separately cannot support a *prima facie* case of obviousness because it fails to consider Applicant's claimed invention as a whole. See M.P.E.P. § 2141.02.

At most, the Office Action's separate discussions of front and rear motorcycle tires might shed some light on whether a person of ordinary skill in the art might have found it obvious to use a front motorcycle tire according to Applicant's claims in some applications and to use a rear motorcycle tire according to Applicant's claims in other applications. But these arguments do not address the question of whether a person of ordinary skill in the art would have found it obvious to ever use the two different motorcycle tires together in the same application. And the cited references contradict the Office Action's implicit conclusion that a person of ordinary skill in the art would find

it obvious to randomly mix and match front and rear motorcycle tire tread patterns within a given pair of front and rear tires. For example, JP '907 shows multiple pairs of front and rear motorcycle tires, each pair having substantially the same tread configuration in the central zones of both the front and rear motorcycle tires. See Figs. 1-3. This would lead a person of ordinary skill in the art away from Applicant's invention of using a front motorcycle tire with one central tread pattern and a rear motorcycle tire with a different tread pattern in the same tire. None of the cited references discloses a pair of front and rear motorcycle tires having different tread patterns.

With this evidence undermining the conclusion of obviousness, the Office Action attempts to support the rejections with voluminous speculation and numerous red herrings. For example, the Office Action advances that "the use of a known tread pattern for its known intended use (e.g. front tire) obtains only the expected and predictable results (e.g. preventing hydroplaning in the case of a front tire)." Office Action at p. 6 (emphasis added). Even if this assertion held true (which Applicant does not concede), it fails to support the conclusion of obviousness because it answers an irrelevant question. With respect to Applicant's claims, it does not matter whether using a single known tread pattern would produce only expected and predictable results because Applicant's claims recite using two different tread patterns in a pair of front and rear motorcycle tires. The Office Action provides no viable evidence or explanation establishing that using two different tread patterns in a pair of front and rear motorcycle tires would produce "expected and predictable results."

The Office Action further asserts that "one of ordinary skill in the art would readily appreciate that different tread patterns should be used for the front and rear tire since

(1) Armellin teaches that the front tire and rear tire of a motorcycle tire should be different." Office Action at p. 6. Implying that Armellin remotely suggests that the tread pattern of a rear motorcycle tire should differ from the tread pattern of a front motorcycle tire egregiously mischaracterizes the reference. Armellin teaches only that the curvature ratio of front and rear motorcycle tires should differ. Col. 8, ll. 24-34.

Furthermore, even within its separate consideration of the selection of front and rear motorcycle tires, the Office Action mischaracterizes the suggestions of the cited references. For example, in discussing the selection of a rear motorcycle tire, the Office Action asserts that Japan 218 "suggests providing a **rear motorcycle tire having a size such as 180/55ZR17** with a tread comprising inclined grooves on both sides of a central area comprising the equatorial plane and having a null sea/land ratio (Figure 1) to improve grip performance at turning or straight line acceleration on a wet road." Office Action at p. 5 (bolding in original, underlining added). Contrary to the implication of this assertion, Japan 218 discloses that these purported performance benefits stem from features of the tire other than the sea/land ratio in the central tread band, these features including:

- i) a tread pattern with a specific direction of rotation consisting a plurality of inclined major grooves that are inclined to the same direction toward one of tread edges from center or near center of the tread width of the tread section, arranged each other in an inverting V shape,
- ii) a specific inclination of major grooves which must have groove edges at which the inclined angle with respect to the tread circumference direction gradually increases as going toward the tread edges from center or near center of tread width;

iii) a specific inclination of each groove wall toward the groove bottom from both groove edges of the inclined major grooves, the inclined angles on the kick-out side of the tread during tire rotation are equal to or bigger than those at the tread-in side in the central region of the tread width, while the inclined angles on the tread-in side of the tread are equal to or bigger than those on the kick-out side in the bilateral regions covering from outer edge of the width central region to the tread edge; and

iv) a magnitude relationship transitional region for the inclined angles at the inclined major groove walls between the tread central region and the bilateral regions.

See, e.g., ¶¶ [0001]; [0005]-[0010]; [0016]-[0020]. Japan 218 particularly points to the variation of the groove wall inclination angle as providing the desired grip improvement. ¶¶ [0020] and [0032]. Indeed, the discussion of comparative experimentation in paragraphs [0026]-[0031] discusses the groove wall inclination as the only parameter that positively affects the amount of grip achieved. Japan 218 does not teach or suggest that providing a rear motorcycle tire with a null sea/land ratio in the center of its tread band provides any improvement in gripping performance, as alleged by the Office Action, much less that it may provide any other useful technical effect. Japan 218 never mentions the sea/land ratio of the central tread region and never suggests anything positive results from configuring a tire with a null sea/land ratio in its central tread region. To the contrary, the comparative experimentation discussed in paragraphs [0026] through [0031] of Japan 218 suggests that the tire of Fig. 1 with a null sea/land ratio in its central tread region provides inferior performance relative to the tire of Fig. 4 with a sea/land ratio greater than zero in its central tread region.

Thus, an objective reading of Japan 218 would suggest things completely different from what the Office Action posits. The reference does not recognize that the

sea/land ratio in the central area of the tread band constitutes a result-effective variable for improving grip or any other performance characteristic. Thus, Japan 218 would suggest focusing on groove wall inclination, not the sea/land ratio of the central tread region, to improve grip.

Furthermore, even if a person of ordinary skill in the art did consider the sea/land ratio of the central tread region, Japan 218 would not suggest implementing the claimed null sea/land ratio for the central region of a rear tire. The disclosure that the tire of Fig. 1 provides inferior performance to that of the tire of Fig. 4 would suggest that a null sea/land ratio in the central tread band region would, *per se*, have poor grip performance. Accordingly, to the extent a person of ordinary skill in the art might derive anything from Japan 218 regarding what sea/land ratio to implement in the central tread region, he or she would infer to adopt a tire with a sea/land ratio greater than zero to improve grip. Thus, Japan 218 teaches away from the claimed invention and cannot support a *prima facie* case of obviousness. See Tec Air, Inc. v. Denso Mfg. Michigan Inc., 192 F.3d 1353, 1360 (Fed. Cir. 1999), citing In re Gurley, 27 F.3d 551, 553 (Fed. Cir. 1994). McGinley v. Franklin Sports, Inc., 262 F.3d 1339, 1354 (Fed. Cir. 2001), citing In re Gurley, 27 F.3d 551, 553 (Fed. Cir. 1994).

Like Japan 218, Japan 907 fails to teach or suggest that providing a tire with a null sea/land ratio in a central tread region provides any advantage. Japan 907 focuses on addressing "heel-and-tow bias abrasion" at the grooves of front and rear tires by mounting the front and rear tires with their grooves angled in opposite directions. See "Problems to Be Solved" section; and "Means for Solving the Problems" section. The reference does not mention the sea/land ratio of tires. The reference fails to recognize

the sea/land ratio of the central tread region as a result-effective variable for improving performance on wet ground, kilometeric yield, wear regularity, and traction characteristics while finding at the same time the best possible compromise between these characteristics. Demonstrating Japan 907's failure to recognize these benefits of the claimed central null sea/land ratio on the rear motorcycle tire, Fig. 1 of the reference discloses an embodiment with a groove in the center of its front and rear tires. The reference does not express any benefit of the null sea/land ratio in the central tread region of the tires of Fig. 2 compared to the sea/land ratio greater than zero in the central tread region of the tires of Fig. 1. Thus, Japan 907 would suggest focusing on the direction of the grooves in the front and rear tires, not on the sea/land ration in the central region of the tread.

To the extent a person of ordinary skill in the art might have tried to glean some wisdom regarding selection of sea/land ratios of the central tread regions of motorcycle tires from Japan 907, the reference would have only lead him or her away from the claimed invention. Japan 907 objectively demonstrates only one preference in this aspect of tire selection: that the front and rear tires in any given pair have the same sea/land ratio in their central tread regions. Some embodiments of Japan 907 have a groove in the central tread regions of their tires (Figs. 1 and 3), and one embodiment lacks a groove in the central tread region of its tires (Fig. 2). But every embodiment has the same configuration (i.e., grooved or ungrooved) in the central tread region of its front tire as it does in the central tread region of its rear tire. Thus, Japan 907 would discourage a person of ordinary skill in the art from the claimed approach of pairing a



front motorcycle tire having one sea/land ratio in its central tread region with a rear motorcycle tire having a different sea/land ratio in its central tread region.

Given the foregoing deficiencies of the cited motorcycle tire references, the Office Action attempts to hedge its position by "optionally" citing German 624. Office Action at p. 6. Contrary to the assertion of the Office Action, a person of ordinary skill in the art would not look to German 624 in deciding the appropriate configuration of motorcycle tires because German 624 discusses only tires used on four-wheeled vehicles. A person of ordinary skill in the art would understand that dramatically different handling characteristics of motorcycles and four-wheeled vehicles create significantly different design considerations for motorcycle tires. Accordingly, German 624 constitutes non-analogous art and cannot support a *prima facie* case of obviousness. See M.P.E.P. § 2141.01(a)l.

Additionally, Applicant respectfully submits that German 624 teaches away from the claimed invention. German 624 states that "[a]nother advantage stems from the fact that the tread profile of the rear tire is formed from one or several main circumferential grooves extending continuously in the circumferential direction of the tire in the middle segment of the tread strip." English Translation of German 624 at pp. 4 and 5. Applicant respectfully submits that this would discourage a person of ordinary skill in the art from implementing the features of claims 38-51, 53-64, and 75 that "the tread band of the rear motorcycle tire comprises: an area defining a substantially null sea/land ratio within a central zone of the tread band of the rear motorcycle tire," as well as the features of claim 65-74 of "providing a substantially null sea/land ratio within a central zone of the tread band of the rear motorcycle tire." German 624 would discourage a

person of ordinary skill in the art from implementing the claimed "substantially null sea/land ratio within a central zone of the tread band of the rear motorcycle tire" because German 624 would lead a person of ordinary skill in the art that this claimed construction would not enjoy the advantages of having one or several main circumferential grooves in the middle portion of the rear tire.

Because it would discourage a person of ordinary skill in the art from implementing the claimed invention, German 624 teaches away from the claimed invention. Tec Air, Inc. v. Denso Mfg. Michigan Inc., 192 F.3d 1353, 1360 (Fed. Cir. 1999), citing In re Gurley, 27 F.3d 551, 553 (Fed. Cir. 1994). A reference that teaches away from a claimed combination generally cannot support a *prima facie* case of obviousness of that claimed combination. McGinley v. Franklin Sports, Inc., 262 F.3d 1339, 1354 (Fed. Cir. 2001), citing In re Gurley, 27 F.3d 551, 553 (Fed. Cir. 1994).

In response to Applicant's prior explanation that German 624 constitutes non-analogous art and teaches away from the claimed inventions, the Office Action turns to further speculation and red herrings. For example, in attempt to salvage its theory that German 624 constitutes analogous art, the Office Action suggests that the only difference between designing tires for four wheeled vehicles and designing tires for motorcycles is that four wheeled vehicles require left and right tires, in addition to front and rear tires. See Office Action at p. 8. In attempt to support this assertion, the Office Action notes that the rear tire of a motorcycle follows the front tire when the motorcycle travels in a straight line, just as the rear tire of a four-wheeled vehicle follows the front tire when the car travels in a straight line. Id. This proves nothing regarding the likelihood of a person of ordinary skill in the art looking to a disclosure related to four-

wheeled-vehicle tires for guidance in designing motorcycle tires. One could observe many other superficial similarities between four-wheeled-vehicle tires and motorcycle tires. For example, motorcycle tires and four-wheeled-vehicle tires share round shapes and, usually, elastomeric construction. But those of ordinary skill in the art recognize that beyond these and other very superficial similarities, motorcycle tires and four-wheeled-vehicle tires have dramatically different design requirements. Thus, contrary to the implication of the Office Action, a person of ordinary skill in the art would not blindly apply disclosures like those of German 624 about four-wheeled vehicle tires to motorcycle tires.

The Office Action also peculiarly asserts that German 624 would not discourage a person of ordinary skill in the art from implementing a rear tire having a substantially null sea land ratio in its central zone. Office Action at p. 8. In support of this assertion, the Office Action merely points to Fig. 1 of German 624 without any further explanation. Id. If Fig. 1 of German 624 disclosed subject matter that anticipated Applicant's claimed invention, that would moot the issue of whether other portions of German 624 teach away from the claimed invention. See M.P.E.P. § 2131.05. But Fig. 1 of German 624 does not anticipate Applicant's claimed invention, and the Office Action cannot avoid the portion of German 624 teaching away from Applicant's claimed invention by considering only what Fig. 1 discloses. Rather, "[a] prior art reference must be considered in its entirety, i.e., as a whole, including portions that would lead away from the claimed invention." M.P.E.P. § 2141.02(VI) (emphasis in original), citing W.L. Gore & Associates, Inc. v. Garlock, Inc., 721 F.2d 1540, 220 USPQ 303 (Fed. Cir. 1983), *cert. denied*, 469 U.S. 851 (1984).

In addition to trying to disregard the portions of German 624 that contradict the conclusion of obviousness, the Office Action further attempts to have its cake and eat it too by asserting that "German 624 is an optional reference." Office Action at p. 8. This is improper. The Office Action must either unequivocally cite the reference and accept the consequences of doing so or support its positions without relying on the reference. "Where a reference is relied on to support a rejection, whether or not in a minor capacity, that reference should be positively included in the statement of the rejection." M.P.E.P. § 706.02(j) (citing In re Hoch, 428 F.2d 1341, 1342 n.3, 166 USPQ 406, 407 n. 3 (CCPA 1970)).

The Office Action further asserts that German 624 "is not necessary to establish a *prima facie* case of obviousness." Office Action at p. 8. To the contrary, due at least to the numerous deficiencies outlined above, the Office Action fails to establish a *prima facie* case of obviousness with or without German 624.

In sum, the Office Action's voluminous speculation fails to produce any viable evidence or explanation supporting its assertion that a person of ordinary skill in the art would have actually found it obvious to combine no less than eight references in just the right way to arrive at Applicant's claimed invention.<sup>1</sup> Accordingly, it appears the rejections of Applicant's claims result from the use of Applicant's own disclosure "as a guide through the maze of prior art references, combining the right references in the right way so as to achieve the result of [Applicant's claimed invention]," which constitutes improper hindsight reconstruction. Grain Processing Corp. v. American

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<sup>1</sup> Applicants do not concede that the suggested combination of references includes all of the features recited in Applicant's claims.

Maize-Products, 840 F.2d 902, 907 (Fed. Cir. 1988), citing Orthopedic Equipment Co. v. United States, 702 F.2d 1005, 1012 (Fed. Cir. 1983).

Thus, the Office Action does not establish a *prima facie* case of obviousness of claims 38-51 and 53-75. Accordingly, Applicant respectfully requests withdrawal of the rejections of these claims under 35 U.S.C. § 103(a).

#### **New Claims 76-96**

Applicant respectfully submits that new claims 76-96 patentably distinguish over the cited references. In a pair of motorcycle tires according to any of claims 76-96, “at least one circumferential groove extends at an equatorial plane of the front motorcycle tire within a central zone of the tread band of the front motorcycle tire” and “the tread band of the rear motorcycle tire comprises: an area defining a substantially null sea/land ratio within a central zone of the tread band of the rear motorcycle tire.” Applicant respectfully submit that these claim features patentably distinguish over the cited references for substantially the reasons discussed above that similar features of claims 38-51, 53-64, and 75 distinguish over the cited references.

Additionally, claims 76-96 recite other features that further distinguish over the cited references. For example, in a pair of pneumatic motorcycle tires according to any of claims 76-96, “a tread band of the front motorcycle tire comprises: at least one circumferential groove; . . . wherein the at least one circumferential groove extends at an equatorial plane of the front motorcycle tire within a central zone of the tread band of the front motorcycle tire, wherein the at least one circumferential groove axially crosses the equatorial plane of the front motorcycle tire in a substantially winding fashion, wherein the at least one circumferential groove comprises a plurality of curvilinear

segments having respective circumferentially staggered centers of curvature positioned at opposite sides of the equatorial plane of the front motorcycle tire, wherein the curvilinear segments have a radius of curvature greater than or equal to about 60 mm and less than or equal to about 180 mm, wherein the central zone of the tread band of the front motorcycle tire extends astride the equatorial plane of the front motorcycle tire, wherein the central zone of the tread band of the front motorcycle tire has a width greater than or equal to about 10% and less than or equal to about 25% of an axial development of the tread band of the front motorcycle tire" (emphasis added).

In an attempt to address similar features of dependent claims 39 and 49-51, the Office Action cites Japan 215 and Haas. Office Action at pp. 8 and 9. Applicant respectfully submits that Japan 215 and Haas fail to teach or suggest the foregoing features of claims 76-96.

In the rejection of claim 39, the Office Action posits that claim recitations regarding the width of the central zone of the tread band "fail to require the central zone to have structure different from that disclosed by Haas or Japan 215." Office Action p. 8. This assertion fails to recognize that, in addition to specifying the width of the central zone of the tread band, the claims specify that "the at least one circumferential groove extends at an equatorial plane of the front motorcycle tire within [the] central zone of the tread band" (emphasis added). Taken together, these features of the claims define the maximum possible width of the circumferential groove. In the case of claims 76-96 specifically, the claim features, read together, define the maximum width of the circumferential groove as 25% of the axial development of the tread band.

Applicant respectfully submits that Japan 215 fails to meet these claim features.

Japan 215 suggests, in order to reduce the height of water spattering in the forward direction of a vehicle body even when the depth of water is deep on a wet road surface or when travelling at a fast speed, to provide a tire for motor scooters, wherein a main groove continuous in the circumferential direction of the tire crossing the equator of the tire in a zigzag form is provided in 1/3 of a region of the tread deployment width around the equator of the tire on the tread surface so that the angle of inclination of the main groove exceeds 20° with respect to the equator of the tire. See ¶¶ [0004] and [0005] and Fig. 1. Thus, the main groove in the center of the tire of Japan 215 has a maximum width of over 33% of the axial development of the tread band, significantly more than the 25% maximum width of the circumferential groove recited in the claims. Thus, Japan '215 fails to teach or suggest that the axial width of the central zone of the tread band should be limited to a maximum of 25% of an axial development of the tread band of the front motorcycle tire.

Japan 215 also fails to meet the features of the claimed circumferential groove because the "main groove" of the tire in Japan 215 has a different shape than the claimed circumferential groove. The claimed circumferential groove "comprises a plurality of curvilinear segments having respective circumferentially staggered centers of curvature positioned at opposite sides of the equatorial plane of the front motorcycle tire" (emphasis added). In sharp contrast, the "main groove" of the tire in Japan 215 has a plurality of rectilinear straight segments. See Fig. 1. Additionally, because the segments of the main groove of Japan 215 take the form of rectilinear straight

segments, they cannot meet the claim features of having a "radius of curvature greater than or equal to about 60 mm and less than or equal to about 180 mm."

The configuration of the main groove in Japan 215 creates a significant disadvantage, namely, an accelerated and irregular wear of the tread band. This results because the zigzag form of the main groove creates a number of sharp points (see Fig. 1), which define rubber portions have a relatively high mobility and which are prone to accelerated and irregular wear phenomena (rubber chipping or chunking) of the tread band. Thus, the main groove of Japan 215 not only fails to meet the features of the claimed circumferential groove but also presents significant disadvantages relative to the claimed circumferential groove.

Haas similarly fails to even come close to meeting the features of the claimed circumferential groove. Whereas the claimed circumferential groove has a plurality of curvilinear segments, Haas has a straight central groove 20. See Fig. 2. Because Haas' central groove 20 does not have the claimed curvilinear segments, Haas also fails to teach or suggest the claimed features regarding the radius of curvature of each of the curvilinear segments.

Regarding the claimed features related to the width of the central zone of the tread band, Haas never even mentions the width of the central zone of the tread band including the circumferential groove. As a matter of fact, according to Haas such a parameter has no importance at all, while the axial width of the central zone of the tread band is vice versa important when the circumferential groove axially crosses the equatorial plane, as is now required by claim 76, to define the possible maximum width of the circumferential groove.



Japan 215 and Haas also fail to teach or suggest other features of claims 76-96. For example, in a pair of pneumatic motorcycle tires according to any of claims 76-96 includes, "a tread band of the front motorcycle tire comprises: . . . a plurality of transverse grooves, . . . wherein the transverse grooves alternately extend from the central zone of the tread band of the front motorcycle tire toward axially opposite shoulder zones of the tread band of the front motorcycle tire, wherein the transverse grooves define, with a running direction of the front motorcycle tire, a first angle greater than or equal to about 30° and less than or equal to about 60° as measured upstream of the transverse grooves" (emphasis added). Japan 215 and Haas both have their transverse grooves disposed at a significantly greater angle than 60° "as measured upstream of the transverse grooves." As can be seen in Fig. 1 of Japan 215, the angle of inclination of its auxiliary grooves 3 exceeds at least 100° as measured upstream of the transverse grooves, rather than the claimed "angle greater than or equal to about 30° and less than or equal to about 60°."

Haas similarly fails to teach or suggest these claim features. Haas never mentions the inclination angle of the transversal grooves nor even remotely suggests that this parameter is a result-effective parameter for achieving any useful technical effect. Also, it is to be noted that this reference would have suggested at best an inclination angle of the transversal grooves which is well above the claimed ones if the angle is measured, as now specified in the claim 76, upstream of the grooves, thereby suggesting an inclination of the transversal grooves which is the opposite of the claimed one with respect to running direction of the tire (i.e. pointing forward instead of pointing backward). Thus, Haas also fails to teach or suggest the claim features of "the

transverse grooves define, with a running direction of the front motorcycle tire, a first angle greater than or equal to about 30° and less than or equal to about 60° as measured upstream of the transverse grooves" (emphasis added).

For at least the foregoing reasons, Japan 215 and Haas fail to teach or suggest the features of claims 76-96 related to the circumferential groove. The other cited references also fail to teach or suggest these claim features. Additionally, as noted above, claims 76-96 distinguish over the cited references for substantially the same reasons that claims 38-51, 53-64, and 75 do. Accordingly, Applicant respectfully requests examination and allowance of claims 76-96.

#### **New Claims 97-118**

Applicant respectfully submits that new claims 97-118 patentably distinguish over the cited references. In a pair of motorcycle tires according to any of claims 97-118, "at least one circumferential groove extends at an equatorial plane of the front motorcycle tire within a central zone of the tread band of the front motorcycle tire" and "the tread band of the rear motorcycle tire comprises: an area defining a substantially null sea/land ratio within a central zone of the tread band of the rear motorcycle tire." Applicant respectfully submit that these claim features patentably distinguish over the cited references for substantially the reasons discussed above that similar features of claims 38-51, 53-64, and 75 do.

Additionally, Applicant respectfully submits that new claims 97-118 distinguish over the cited references for other reasons. For example, in a pair of pneumatic motorcycle tires according to any of claims 97-118, "a tread band of the front motorcycle tire comprises: . . . a plurality of transverse grooves, . . . wherein the transverse grooves

alternately extend from the central zone of the tread band of the front motorcycle tire toward axially opposite shoulder zones of the tread band of the front motorcycle tire, wherein the transverse grooves define, with a running direction of the front motorcycle tire, a first angle greater than or equal to about 30° and less than or equal to about 60° as measured upstream of the transverse grooves" (emphasis added). Applicant respectfully submits that the cited references fail to teach or suggest these claim features for at least the reasons discussed above in connection with similar features of claims 76-96.

Additionally, in a pair of pneumatic motorcycle tires according to any of claims 97-118, "the tread band of the front motorcycle tire comprises: . . . a plurality of transverse grooves; . . . wherein the transverse grooves in the tread band of the front motorcycle tire are circumferentially distributed along the tread band in axially opposite groups comprising at least two transverse grooves, wherein the axially opposite groups of transverse grooves are circumferentially staggered, wherein the tread band of the front motorcycle tire further comprises at least one transverse groove in the tread band of the motorcycle tire on either side of the equatorial plane of the front motorcycle tire between the axially opposite and circumferentially staggered groups of transverse grooves" (emphasis added). In attempt to address similar features of dependent claims 46-47, the Office Action points to Japan 215, without providing any substantive discussion of how this reference purportedly meets these claim features. See Office Action at p. 9. Applicant respectfully submits that Japan 215 does not teach or suggest the foregoing features of the claims. Japan 215 does not disclose any staggered groups of grooves but staggered single auxiliary grooves (3) extending from the zigzag

portions of the circumferential groove (main groove 2) and, further, it is totally silent as to the presence of additional transverse grooves on either side of the equatorial plane of the front motorcycle tire between the axially opposite and circumferentially staggered groups of transverse grooves. Thus, a person skilled in the art would have never arrived at the pair of tires of new independent claim 97 even by combining Haas and Japan 215 with Armellin.

Apparently recognizing that the combination of Armellin, Haas, and Japan 215 fails to meet these claim features, the Office Action attempts to hedge its position by citing Nakagawa and Japan 307. Office Action at p. 10. But the Office Action does not provide any logical reason that anyone would modify the tires disclosed by Haas and Japan 215 based on Nakagawa and Japan 307. Instead, the Office Action states that a person of ordinary skill in the art would have found it obvious to combine the claimed references in the suggested manner for the purpose of having a tire that meets the claim features. Id. This amounts to improper hindsight reasoning.

Furthermore, Applicant respectfully submits that Nakagawa and Japan 307 suggest that the transverse grooves should not be connected to the circumferential groove and, as such, teach away from the configuration suggested by Haas or Japan 215, which both indicate that such a connection should exist. Thus, contrary to the assertion of the Office Action, a person of ordinary skill in the art would not have had a reason to combine Haas and Japan 215 with Nakagawa or Japan 307.

Furthermore, even if a person of ordinary skill in the art did combine the references as suggested by the Office Action, despite the lack of any rational reason to do so, the combination would still fail to meet all of the claim features. For example, the

combination would still fail to meet at least the claim features that "the transverse grooves define, with a running direction of the front motorcycle tire, a first angle greater than or equal to about 30° and less than or equal to about 60° as measured upstream of the transverse grooves."

For at least the foregoing reasons, Applicant respectfully submits that new claims 97-118 patentably distinguish over the cited references. Accordingly, Applicant respectfully requests examination and allowance of new claims 97-118.

**New Claims 119 and 120**

Applicant respectfully submits that new claims 119 and 120 patentably distinguish over the cited references for reasons similar to those discussed above that new claim 76-96 do. Accordingly, Applicant requests examination and allowance of new claims 119 and 120.

**New Claims 121 and 122**

Applicant respectfully submits that new claims 121 and 122 patentably distinguish over the cited references for reasons similar to those discussed above that new claim 97-118 do. Accordingly, Applicant requests examination and allowance of new claims 119 and 120.

**Conclusion**

In view of the foregoing amendments and remarks, Applicant respectfully requests reconsideration and reexamination of this application and the timely allowance of the pending claims.

The Office Action contains characterizations of the claims and the related art with which Applicant does not necessarily agree. Unless expressly noted otherwise, Applicant declines to subscribe to any statement or characterization in the Office Action.


Please grant any extensions of time required to enter this response and charge any additional required fees to our deposit account 06-0916.

If the Examiner believes a telephone conversation might advance prosecution, the Examiner is invited to call Applicant's undersigned agent at 202-408-4492.

Respectfully submitted,

FINNEGAN, HENDERSON, FARABOW,  
GARRETT & DUNNER, L.L.P.

Dated: November 2, 2011

By:   
Neil T. Powell  
Reg. No. 45,020

**Attachments:** English translation of Japan 215

English translation of Japan 218

English translation of Japan 907